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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,215	02/09/2001	Omar M. Buazza	5040-04205	6988

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/780,215

Applicant(s)

BUAZZA ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 293-296, 298-310, 443-461 and 463-474 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 293-296, 298-310, 443-461 and 463-474 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 4, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submissions filed on September 25, 2003 and November 20, 2003 have been entered.

2. The terminal disclaimer filed on September 25, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on U.S. Patent Application Nos. 09/780,076; 09/789,000; 09/788,998; 09/789,195; and 10/188,261 has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 293-296, 302, 443-454, 458-461, 467, and 473-474 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al. (U.S. Pat. No. 6,068,464) in view of EP 0 318 164 (previously of record; hereinafter "EP '164").

Su discloses the apparatus substantially as claimed in the instant application. More specifically, Su discloses a lens forming apparatus in combination with a programmable logic controller computer. The lens forming apparatus comprises a front mold member (50) having a casting face, a non-casting face (figure 2). The apparatus also comprises a back mold member (40) having a casting face, a non-casting face (figure 2). The back mold member is spaced apart from the front mold member by a gasket (20) during use. The casting faces of the front mold member, the back mold member and an inner surface of the gasket define a mold cavity (31) which defines a shape corresponding to an eyeglass lens prescription during use. The gasket is provided with a fill port for receiving a lens forming composition when the gasket is engaged with a mold set (col. 20, ll. 16-21).

The apparatus further comprises a lens curing unit (300) configured to direct activating light toward the mold members during use (col. 23, ll. 23-35). The curing unit comprises first and second light sources (312) configured to generate and direct activating light toward the mold members.

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The controller computer comprises input and output devices for obtaining and transmitting information to and from the user (col. 12, l. 56 - col. 13, l. 13). The controller computer is configured to control the operation of the lens curing unit during use and to adjust lens curing conditions in the lens curing unit based on the eyeglass prescription during use (col. 12, ll. 56-64 and col. 23, ll. 30-35). Su further discloses the controller computer to comprise a display screen (monitor) as the output device, and for instructions to be transmitted to the operator during use of the system (col. 13, ll. 6-13).

Su further discloses the front and back mold members to have identification markings and the controller computer being configured to recognize the markings (col. 17, ll. 35-50). However, Su does not disclose the gasket to comprise identification markings, with the controller configured to determine the gasket identification markings. Su also does not disclose the apparatus to comprise a coating unit.

EP '164 discloses a lens forming apparatus and controller. EP '164 provides mold members and gaskets with bar code identification markings (p. 4, ll. 35-36). EP '164 further discloses the controller to be configured to determine the gasket identification markings for the purpose of, among other things, identifying the particular job being filled (p. 4, ll.

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39-40). EP '164 also discloses the apparatus as comprising a mold coating unit (14) for the purpose of applying release agents to the mold elements (p. 4, ll. 26-27 and p. 9, ll. 23-58).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the apparatus Su as such to have used gasket identification markings in conjunction with the controller because the provides a way for the system to keep track of the particular job being filled as suggested by EP '164.

It also would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the apparatus of Su as such to further provide a coating unit working in conjunction with the controller because this would allow for release agents to be applied to the mold members as suggested by EP '164.

7. Claims 299 and 464 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su modified by EP '164 as applied to claims 293-296, 302, 443-454, 458-461, 467, and 473-474 above, and further in view of Blum et al. (U.S. Pat. No. 4,919,850; previously of record).

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Su and EP '164 discloses and suggest the apparatus and controller as described above. Notably, Su has been shown to disclose the apparatus to comprise first and second light sources (312). However, neither Su nor EP '164 suggest the controller to be configured to individually control the first and second light sources of the lens curing unit.

Blum discloses a lens curing apparatus and controller. Blum discloses the apparatus to comprise two sets of UV light curing sources (102 and 104) independently controlled by controller in order to tailor the resulting curing to a particular molding material (col. 6, ll. 37-64).

It would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to have modified the apparatus disclosed and suggested by Su and EP '164 as such to have the lens curing unit's two light sources independently controlled by a controller because this would have allowed the apparatus to be configured to optimally cure particular molding materials as suggested by Blum.

8. Claims 298 and 463 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su modified by EP '164 as applied to claims 293-296, 302, 443-454, 458-461, 467, and 473-474 above,

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and further in view of Buazza et al. (U.S. Pat. No. 6,086,799; previously of record; hereinafter "Buazza '799").

Su and EP '164 disclose and suggest the apparatus and controller as described above. Su and EP '164 do not disclose the apparatus to further comprise a light sensor configured to measure the dose of light transmitted to the mold cavity, wherein the light sensor is configured to communicate with the controller, and wherein the controller varies the intensity or duration of light such that a predetermined dose is transmitted to the mold cavity.

Buazza '799 discloses a lens molding apparatus comprising a light sensor configured to measure the dose of light transmitted to the mold cavity, wherein the light sensor is configured to communicate with the controller, and wherein the controller varies the intensity or duration of light such that an optimal predetermined dose is transmitted to the mold cavity (col. 45, l. 56 - col. 46, l. 9).

It would have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to have modified the apparatus disclosed and suggested by Su and EP '164 as such to have lens molding apparatus further comprise a light sensor working in conjunction with a controller because this would have

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allowed to the lens to be optimally cured with predetermined doses of light as suggested by Buazza '799.

9. Claims 300-301, 455-457 and 465-466 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su modified by EP '164 as applied to claims 293-296, 302, 443-454, 458-461, 467, and 473-474 above, and further in view of Buazza et al. (U.S. Pat. No. 5,989,462; previously of record; hereinafter "Buazza '462").

Su and EP '164 disclose and suggest the apparatus and controller as described above. Su and EP '164 do not disclose the controller to be configured to perform system diagnostic checks and notify the user when the system requires maintenance. Su and EP '164 also do not disclose the apparatus to comprise filters disposed between the mold members and the activating light sources.

Buazza '462 discloses an eyeglass lens molding apparatus with a controller. The controller is programmed to perform system diagnostics and notify the user when the system requires maintenance for safety purposes (col. 101, ll. 30-35). Buazza '462 further discloses the use of filters (54 and 56) positioned between the activating light sources and the mold members for the purpose of manipulating the light emanating from the light

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sources such to achieve a desired intensity of light reaching the molding material (col. 11, ll. 23-41).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the controller disclosed and suggested by Su and EP '164 as such to have made the controller perform system diagnostics as well as notify the user when the system requires maintenance because this would help in ensuring safe operation of the apparatus as suggested by Buazza '462.

It also would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the apparatus disclosed and suggested by Su and EP '164 as such to have used filters disposed between the mold members and the activating light sources because this would allow for making an optimum intensity of light reach the molding material as suggested by Buazza '462. Positioned between the mold members and the activating lights, the filters would also act as thermal barriers between the light sources and the rest of the lens curing chamber.

10. Claims 303-310 and 468-472 are rejected under 35

U.S.C. 103(a) as being unpatentable over Su modified by EP '164 as applied to claims 293-296, 302, 443-454, 458-461, 467, and

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473-474 above, and further in view of WO 98/28126 (hereinafter "WO '126").

Su and EP '164 disclose and suggest the apparatus and controller as described above. Notably, the references disclose the controller computer using prescription information to determine curing conditions. However, Su and EP '164 do not disclose the controller computer to be configured to run a program with a plurality of instructions which operate with prescription information including such lens characteristics as sphere power, cylinder power, and add power.

WO '126 discloses a lens forming apparatus and corresponding controller computer. WO '126 discloses the use of various lens characteristics being input into the controller computer, with the controller computer using the lens characteristics to run the apparatus (see for example, p. 13, ll. 1-7). WO '126 notes that this prescription information aids in ensuring the appropriate curing cycles are used (p. 13, ll. 7-8).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the apparatus and controller disclosed and suggested by Su and EP '164 as such to have the controller computer use additional lens

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prescription data because this would aid in ensuring that appropriate curing cycles are used as suggested by WO '126.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions

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on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Donald Heckenberg', is written over the printed name.

Donald Heckenberg
February 3, 2004